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EXAMINER

DAVIS, KATHARINE F

ART UNIT

PAPER NUMBER

1636

DATE MAILED: 12/14/2001

9

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/810,836

Applicant(s)

BROUN, PIERRE

Examiner

Katharine F. Davis

Art Unit

1636

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) 19-25 and 27-32 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4, 10-12, 18, 26, 33-37 and 43-45 is/are allowed.
- 6) ☒ Claim(s) 5-9, 13, 15-17, 38-42 and 46-50 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☒ Interview Summary (PTO-413) Paper No(s). 9.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *Notice To Comply*.

### **DETAILED ACTION**

This Office Action is in response to the application filed on March 16, 2001 and to the Response To Restriction Requirement filed on October 1, 2001. Claims 1-50 are pending in the instant application.

#### ***Election/Restrictions***

Applicant's election with traverse of Group I (claims 1-18) in Paper No. 7 is acknowledged. Applicant requests that all claims directed to DNA-based assays be searched together. Upon further consideration of Applicants' arguments claim 26 (original Group II) and claims 33-50 (original Group III) are joined with Group I (claims 1-18). Thus, claims 1-18, 26 and 33-50 are examined in this application.

Claims 19-25 and 27-32 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to non-elected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Specification*

The disclosure is objected to because of the following informality: on page 8, line 25, an application serial number is missing and on page 9, line 7, an application serial number is missing. Appropriate correction is required.

The specification contains nucleotide and/or amino acid sequences (pages 18 and 22) that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). It appears that these sequences (on pages 18 and 22) are not included in the originally filed Sequence Listing because they are not identified by SEQ ID NOS. Therefore, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures. Applicant must provide a substitute paper copy and a substitute computer readable copy of the Sequence Listing and a statement that the content of the substitute paper and computer readable copies are the same and, where applicable, include no new matter, as required by 37 CFR 1.821(e) or 1.821(f) or 1.821(g) or 1.825(b) or 1.825(d). A full response to this Office action must include a complete response to the requirement for a new Sequence Listing.

*Claim Objections*

Claim 14 is objected to because of the following informality: claim 14 recites the abbreviation "GUS". An abbreviation should be defined upon first appearance in the claims. Appropriate correction is required.

Art Unit: 1636

*Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-9, 13, 15-17, 38-42 and 46-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 38 recite the term "pathway gene". There is insufficient antecedent basis for this term in the claims.

Claims 13 and 46 recite the term "promoter". There is insufficient antecedent basis for this term in the claims. Both claims also appear to be missing a word "and" between the word "gene" and the word "is" in line 2 of each claim.

Claims 15 and 48 recite the term "promoter" (first use in claim). There is insufficient antecedent basis for this term in the claims.

The term "high-value" in claims 15 and 48 is a relative term which renders the claim indefinite. The term "high-value" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear what metabolites are encompassed by the term "high-value".

*Conclusion*

Claims 5-9, 13, 15-17, 38-42 and 46-50 are rejected. Claim 14 is objected to based on a minor informality. Claims 1-4, 10-12, 18, 26, 33-37 and 43-45 are allowable upon correction of

Art Unit: 1636

the objection to the specification and compliance with the Sequence Rules. Claims 1-18, 26 and 33-50 are free of the prior art. The closest prior art with regard to the allowed claims is determined to be US Patent 5,610,015 (Wickens *et al.*). This reference does not teach or suggest a DNA-based method of determining whether a member of a pool of test transcription factor polynucleotides encodes a pathway transcription factor by identifying which member of the pool of test transcription factor polynucleotides is able to interact with a pathway promoter operably linked to a reporter gene. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katharine F. Davis whose telephone number is (703) 605-1195 with direct desktop RightFax (703) 746-5199. The examiner can normally be reached on Monday-Friday (8:30am-5:00pm). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott can be reached on (703) 308-4003. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 for regular communications and (703) 305-1935 for After Final communications. Any inquiry concerning the formalities of this application should be directed to Patent Analyst Dianiece Jacobs whose telephone number is (703) 305-3388. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Katharine F. Davis  
December 12, 2001

DAVID GUZO  
PRIMARY EXAMINER  
